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81. (NEW) An image transfer member according to claim 80 wherein the release layer comprises less than 1% filler material.

82. (NEW) An image transfer member according to claim 81 wherein the release layer contains less than 0.1% filler material.

REMARKS

The present application now contains claims 29-45 and 66-82. Claims 77-79 have been withdrawn from consideration, but would be patentable if claim 1 is patentable. Claim 29 has been amended to improve its readability. Applicants submit that the amendments to claim 1 are purely cosmetic and do not change the scope of the claim. Claims 80-82 place into independent form the already present limitations of claims 39-41.

The specification is objected to because it introduces new matter, namely the non-tacky nature of the material. Similarly, claims 29-45 and 66-76 are rejected under various paragraphs of 35 U.S.C. §112 for two reasons: (1) they are not based on the disclosure, since they contain the non-tacky limitation; and (2) the phrase "in an amount greater than that normally used for polymerization" renders the claim ambiguous.

In addition, the claims are rejected under 35 U.S.C. §112, second paragraph since in setting forth a physical characteristic of the material, they cover any conceivable combination of ingredients which would impart the desired characteristics.

Applicants submit herewith a second declaration of Mark Aronhime, which presents experiments made to determine if, in the amounts of 10%, which are the limitations set forth in the disclosure, silicone oil renders the blanket tacky. Applicants submit that Dr. Aronhime's experiments prove conclusively that any blankets as manufactured using the recipe set forth in the disclosure are not tacky.

Furthermore, Dr. Aronhime's declaration and the attachments thereto, clearly rebut the Examiner's finding that the phrase "in an amount greater than that normally used for polymerization" renders the claim ambiguous. Since for each commercially available silicone material, the amount of catalyst (curing agent) is recommended by the manufacturer, the term is not ambiguous as indicated by the Examiner.

Applicants wish to clarify a further point with regard to the types of silicone oil described as being used in the translated reference.

Applicants submit that the translated reference describes two types of silicone oil. Only one of these types is relevant to the tackiness property. Applicants further submit that the Examiner has relied on the parts of the translation that refer to the type of silicone oil that is not at all relevant to the present invention as claimed. Thus, applicants respectfully submit the entire thrust of the rejections based on both JP references is incorrect.

One type of silicone oil, having a viscosity of preferably 10,000 or less and preferably less than the viscosity of the liquid raw rubber is described as being an "adjusting agent to improve durability". At page 14, it is also described as improving mold release and cleaning. This agent has a maximum amount of 40%, and no minimum is given, since its use is apparently optional. It is not defined as having any effect on the tackiness of the layer. In the examples, 10% of a 30 cps oil is added. Applicants submit that this lower viscosity oil and references to it in the prior art reference have no bearing on tackiness.

A second type of oil, having a viscosity of 10,000 cps or more and preferably higher than the viscosity of the base oil is described as a tackifier. The silicone oil tackifier is not used in the examples.

A second point should be understood regarding the reference. The reference teaches a combination of a "2-pack *addition type* cold-setting or thermosetting liquid raw silicone rubber" and a tackifier, which is selected from the group consisting of:

- a) a 1- or 2- pack condensation type silicone varnish or its modification product;
- b) a 2-pack addition type cold setting or thermosetting liquid raw rubber;
- c) a solid raw methyl-, phenyl-, vinyl-, phenyl-vinyl, fluoro- or nitrile-silicone rubber; and
- d) a silicone oil with a viscosity of 10000 cps or more.

These combinations are taken from the claim, which tracks the disclosure.

Thus, the translated reference has no teaching of any combination of a tackifying silicone oil with a *condensation* type silicone material, nor is there any teaching in the reference that silicone oil is a tackifying agent for *condensation* cured silicone rubber. Thus, the reference clearly does not anticipate the present claims.

Applicants further respectfully refer the Examiner to page 15 of the translation where the amounts of tackifier and base oil are disclosed. Without specifying which tackifier is used, the limits on amount of tackifier are more than 2% and preferably more than 3% to 90%. Applicants presume that this broad range is meant to cover the ranges of all of the many types of tackifiers

defined. In the Example, tackifier percentages of 30% are used. As indicated above, no example is given for silicone oil as a tackifier.

Claims 29, 39-41 and 76 stand rejected under 35 U.S.C. §102(b) as being clearly anticipated by Ryoichi (JP 57-020742). Applicants do not understand why this reference, for which only an abstract is available, was presented. For the purpose of this discussion, applicants assume that the relevant portions of reference, is merely an apparatus (use) version of the Japanese reference for which a translation was provided. Applicants note that the new reference is dated only 4 days after the previously cited reference and is assigned to the same assignee. Furthermore, the wording used in the abstract of the newly provided reference is substantially identical to wording used in the translated reference.

Based on this understanding, applicants submit that the JP '742 reference does not provide a *prima facie* case of anticipation. One reason for this submission is given in the preceding paragraphs.

Applicants further submit that any burden on the applicants to prove that the disclosed release layer is non-tacky, has been met by the second declaration of Dr. Aronhime.

Furthermore, the declaration by Dr. Aronhime points out that the viscosity of the silicone base oil used depends primarily on the amount of filler used. As is clear from the specification sheet attached to the declaration, the viscosity of the base oil including the filler material is in the range of 10,000+ cps. Furthermore, it is clear from Dr. Aronhime's declaration that if substantial amounts of filler material are removed from the commercial silicone precursors that he used, the viscosity is 1,000 to 4,000 cps.

The Examiner is referred to page 14 of the translation for a definition of the tackifying silicone oil. It is clear from this definition that 10,000 cps is the range of viscosity of the silicone base materials used and thus, that these materials contain the normal amount of filler materials, on the order of 20%.

Claims 29-33, 35-41 and 76 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wang. Applicants respectfully traverse this rejection. Furthermore, applicants submit that Wang does not provide a *prima facie* case of anticipation.

Wang describes a system in which an image is formed on directly on a paper carrier layer. This image is then transferred to a vinyl sheet. This does not meet the requirement of claim 1 that the transfer member be suitable for the transfer of toner images *received* from a first surface and *transferring* them to a second surface. The image in Wang is *developed* directly onto the paper

carrier sheet of Wang. There is no teaching of how such a paper substrate could be used as an intermediate transfer member. An intermediate transfer member suitable for both receiving and transferring images must have a special construction to operate well. The simple paper substrate of Wang apparently does not meet this requirement.

Furthermore, as is quite clear from the text in Wang, the condensation that is described is not used for forming the polymer. Rather it is used to attach a minor amount of the silicone to a monomer. The actual curing of the material, which is not *per se* "a silicone material" is by polymerization of the monomers and is not connected with the silicone at all. However, this is a secondary observation. The reference just does not teach any intermediate transfer member at all, which is enough to destroy any *prima facie* anticipation as alleged by the Examiner.

As to the question of filler materials, applicants submit that since commercial silicone materials do contain fillers, Wang does contain such materials.

Claims 29-44, 66-74 and 75 stand rejected under 35 U.S.C. §102(b) as being anticipated by JP 57-19753. Applicants submit that this reference does not provide a *prima facie* case of anticipation.

Applicants submit that the declaration of Dr. Aronhime and the discussion of this reference and its "twin" the '742 reference made above, make the arguments advanced by the Examiner moot. Firstly, there is no teaching in the '753 reference of any mixture of a condensation cured silicone material with any *tackifying* silicone oil. Dr. Aronhime's declaration proves that, at least for the preferred *tackifying* silicone oil of the reference with condensation cured silicone (a combination not even mentioned in the reference), the resulting material is not tacky. Furthermore, Dr. Aronhime's declaration shows that the combinations actually taught in the present application are not tacky. Finally, it is clear that the portions of the reference relied on by the Examiner actually refer to a silicone oil that is not a tackifier.

As an aside, applicants note that oxides of metals are not generally conductive.

Claims 29-45 and 66-70 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hendrickson. Applicants submit that Hendrickson does not provide a *prima facie* case of obviousness. Applicants agree that the reference teaches the transfer of an image from the object to a substrate. However, this is only one of the requirements of the claim, which is that the image be transferable to a second surface. However, as has been explained in the past, Hendrickson does not teach an intermediate transfer member which also receives an image from a first surface. In Hendrickson, as in Wang, which was cited as anticipatory, the image is formed on the object (a

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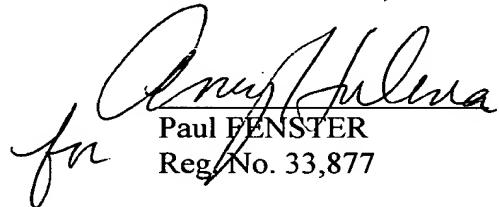
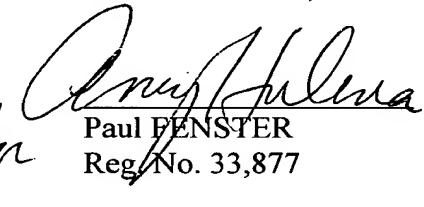
photoreceptor in the case of Hendrickson) by development of a latent image on the surface thereof. This is not what is claimed.

As to the new claims, applicants submit that the prior art does not teach the use of filler free or even reduced filler condensation release layers. As clearly evident from the declaration of Dr. Aronhime, and from the disclosure of the present application, commercially available silicone rubbers do contain large amounts of filler materials. Applicants have found that removal of these filler materials results in glossier images.

If the Examiner has any questions and/or suggestions with respect to the application, the undersigned can be reached at toll free number 1 (877) 428-5486. Kindly note that this is a direct line to the undersigned's office in Israel which is 7 hours ahead of Washington. Usually, the undersigned can be reached at this number before 11:00 AM Washington time. Alternatively, the undersigned can be reached by e-mail at fensterco@attglobal.com.

In view of the above amendments and remarks, applicants submit that the application is ready for allowance. Notice to this effect is respectfully awaited.

Respectfully submitted,
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Marked-Up Amended claims

29. (Amended Three Times) An image transfer member suitable for the [transfer] receiving of toner images [received] from a first surface and [transferring them] their transfer to a second surface, the transfer member comprising a base layer and a non-tacky outer release layer of a condensation cured silicone.

77. (Amended Twice) An imaging method comprising:

- (a) forming a toner image on an imaging surface;
- (b) transferring the image to an image transfer member according to any of claims 29-45, [or] 66-73, 75-[or] 76, 80 or 81.